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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,164	07/02/2001	Eric C. Haseltine	54317-010500	2603

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/898,164

Applicant(s)

HASELTINE ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8,10-13,38-45 and 58-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,10-13,38-45 and 58-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 22 March 2007 and 29 May 2007 have been entered.¹

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 59, 60, 66 and 67 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose an audio/video portion of the programming broadcast signal. The specification does disclose a video/audio *signal* (e.g., at para. [0017], first sentence).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹ Although the claims filed on 29 May 2007 are described as "supplementary", they do in fact supersede, not supplement, the claims filed after final on 22 March 2007 (37 CFR 1.131).

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5. Claims 1-4, 10, 11, 38-42, 58, 61-63, 65 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz et al. (US005523794A) in view of Brusky et al. (US005903259A).
6. Mankovitz et al. teaches (independent claims 1, 38, 58, 62 and 65) a method and system for providing an incentive, the method comprising:
 - providing a programming broadcast signal (*television transmission signals*) to a broadcast receiving appliance (*controller 12*, col. 3 lines 44-49);
 - providing a token (*VBI data*) with the programming broadcast signal (col. 3 lines 44-49);
 - radiating a signal (*a wide band infrared signal*) including the token with the programming from the broadcast receiving appliance (col. 3 lines 49-54);
 - providing a token capture device (*portable electronic coupon 10*) configured to receive the token during the radiating of the programming (col. 3 lines 44-54); and
 - providing an incentive (*discounts on merchandise or services*, col. 5 lines 26-29) for using the token capture device/*portable electronic coupon* to receive the token.
7. Mankovitz et al. does not teach radiating an audio signal including the token, wherein the token is radiated outside of a normal hearing frequency range of an acoustic spectrum of the audio signal. Brusky et al. teaches radiating an audio signal outside of a normal hearing frequency range of an acoustic spectrum (i.e., radiating *inaudible sounds*, col. 7 line 65 to col. 8 line 4). Because Brusky et al. teaches that infrared radiation, audible radiation and inaudible sound radiation provide *equivalent results*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Brusky et al. to those of Mankovitz et al.
8. Neither Mankovitz et al. nor Brusky et al. explicitly teaches that the (inaudible) audio signal includes the token. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, Brusky et al. teaches that all the information conveyable by infrared can be conveyed by inaudible sound. Since Mankovitz et al. teaches that the token can be conveyed by infrared, it necessarily follows that the token can be conveyed by inaudible sound.

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9. Mankovitz et al. also teaches at the citations given above claims 2-4, 11, 41, 42, 61 and 68.
10. Mankovitz et al. also teaches claims 10, 39, 40 and 63 (col. 8 lines 35-41, where a *discount* or any other benefit reads on a "prize").
11. Claims 8, 43-45, 59, 60, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz et al. (US005523794A) in view of Brusky et al. (US005903259A) and further in view of Dedrick (US005604542A).
12. Neither Mankovitz et al. nor Brusky et al. teaches (claims 59, 60, 66 and 67) that the token is included in the audio/video signal/portion of the programming broadcast signal. Dedrick teaches an audio/video advertisement/coupon in the VBI (col. 2 lines 15-22 and col. 3 lines 2-3), which reads on a token included in the audio/video signal/portion of the programming broadcast signal.² Because Dedrick teaches that it is desirable to distribute these electronic ads/coupons to consumers (col. 1 lines 23-26), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Dedrick to those of Mankovitz et al. and Brusky et al. Dedrick's *electronic ad/coupon* with video and audio respectively read on "a motion picture film" (claim 43) and on "a radio broadcast/program" (claims 8 and 44).
13. None of the reference cited above teach that the broadcast signal embodies a computer software program (claim 45). However, Dedrick's *electronic ad/coupon* would read on this limitation if provided with hyperlinks. Official notice is taken (MPEP § 2144.03) that hyperlinks were commonly added to electronic ads, and therefore would have been obvious to one of ordinary skill in the art, at the time of the instant invention.
14. Claims 12, 13 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz et al. (US005523794A) in view of Brusky et al. (US005903259A) and further in view of Clarke (US005502636A). Neither Mankovitz et al. nor Brusky et al. teaches collecting/providing personal information at redemption, and using the stored information in a demographic analysis. Clark teaches collecting/providing personal information at redemption, and using the stored information in a demographic analysis (col. 2 lines 37-41 and 48-55). Because Clark teaches that it is desirable to target and track certain audiences

² An electronic ad with audio/video content within a broadcast signal is inherently included in the audio/video "portion of the programming broadcast signal".

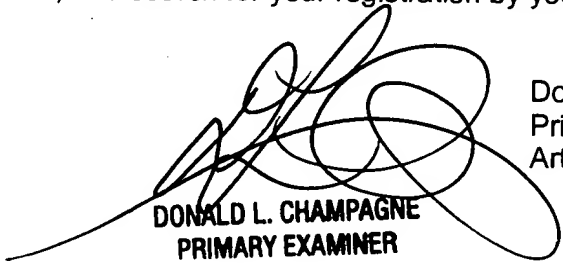
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(col. 1 lines 21-28), and because this personal targeting improves reduces fraud (col. 3 lines 11-13), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Clark to those of Mankovitz et al. and Brusky et al.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
16. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

5 June 2007


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622